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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/872,353	MCCARTHY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alicia Chevalier	1772	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 140-161 and 163-226 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 224-226 is/are allowed.
- 6) ☒ Claim(s) 140-161, 163-165, 169-206 and 210-223 is/are rejected.
- 7) ☒ Claim(s) 166-168 and 207-209 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)          |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. <u>9/2/04</u> .                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/12/04</u> .   | 6) <input type="checkbox"/> Other: _____.                                   |

**RESPONSE TO AMENDMENT**

1. The examiner of record had called Applicant's representative to discuss a possible examiner's amendment to allow the instant Application, as noted in the attached interview summary. However, upon further search and consideration the Application is not considered to be allowable at this time and a non-final action follows.
2. Claims 140-161 and 163-226 are pending in the application, claim 162 has been cancelled.
3. Amendments to the claims, filed on April 19, 2004, have been entered in the above-identified application.

***WITHDRAWN REJECTIONS***

4. The 35 U.S.C. §112 rejections of claim 162, made of record in paper #21, mailed January 15, 2004, pages 2-3, paragraph#6 have been withdrawn due to Applicant's amendment in the response filed April 19, 2004.
5. The 35 U.S.C. §103 rejections made of record in paper #21, pages 3-17, paragraphs #7-14 has been withdrawn due to Applicant's amendment the response filed April 19, 2004.

***NEW REJECTIONS***

6. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

***Claim Rejections - 35 USC § 102***

7. Claims 140, 141, 142, 148, 156, 157, 164, 171, 177, 182, 183, 184, 190, 198, 199, 205, 214, 217, 222 and 223 are rejected under 35 U.S.C. 102(b) as being anticipated by Capozzola (U.S. Patent No. 4,858,957).

Capozzola discloses an identification tag (*title*).

Regarding Applicant's claims 140, 182 and 223, Capozzola discloses a tag (*title*).

The preamble "business cards" is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

The tag comprises a cardstock sheet construction (*tag layer, col. 2, lines 65*) which is deemed to have a front side and a back side, a solid continuous liner sheet (*over lay, col. 1, line 65*) releasably secured with ultraremovable adhesive (*adhesive, col. 3, line 32*) to and covering the back side (*figure 2*). The adhesive is deemed to be an ultraremovable adhesive since the adhesive is completely removable from the tag (*col. 3, lines 31-38*). Portions of the back side of the cardstock sheet construction are deemed to form back side surfaces of the tag.

Continuous through-cut lines (*serrations, col. 3, line 7*) through the cardstock sheet construction to the back side but not through the liner sheet and define at least in part perimeter edges of the tags and a matrix waste portion (*figure 2*). Areas of the liner sheet covering back sides of all of the through-cut lines (*figure 2*). The areas are adapted to hold the tags and the matrix waste portion together (*figure 2*).

The limitation “when the sheet of printable business cards is sheet fed through a printer or copier for a printing operation of the printable business cards” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

The ultraremovable adhesive covers the entirety of the back side of the cardstock sheet construction (*figure 2*).

The liner sheet, the ultraremovable adhesive and the through-cut lines are adapted to allow the tags to be removed from the liner sheet and from the matrix waste portion into individual tags (*figure 2*).

The limitation “after the printing operation” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

The liner sheet, the ultraremovable adhesive and the through-cut lines are adapted to allow the tags to be removed from the liner sheet and from the matrix waste portion into the individual tags with the ultraremovable adhesive remaining on the liner sheet and not on back side surfaces of the tags (*figure 2*).

Furthermore, the back side surfaces of the tags are tack-free after removal from the liner sheet (*col. 3, lines 31-38*).

Regarding Applicant's claims 141 and 183, Capozzola discloses that the liner sheet covers all of the back sides of all of the facestock through-cut lines (*figure 2*).

Regarding Applicant's claims 142 and 184, Capozzola discloses that the liner sheet extends the entire width of the cardstock sheet construction (*figure 2*).

Regarding Applicant's claims 148 and 190, Capozzola discloses that at least some of the through-cut lines define the matrix waste portion around the tags (*figure 2*).

Regarding Applicant's claims 156 and 198, Capozzola discloses that the liner sheet covers the entire back side of the cardstock sheet construction (*figure 2*).

Regarding Applicant's claims 157 and 199, Capozzola discloses that at least some of the through-cut lines define all of the perimeter edges of the tags (*figure 2*).

Regarding Applicant's claims 164 and 205, Capozzola discloses that the cardstock sheet construction and the liner sheet are both rectangular and have the same width and length (*figure 2*).

Regarding Applicant's claim 171, 214 and 222, the back side surfaces of the tags are deemed to be writable thereon by a user after removal from the liner sheet, since the reference discloses that there is no adhesive on the backside of the tags (*col. 3, lines 31-38*).

Regarding Applicant's claim 177 and 217, the cardstock sheet construction includes a cardstock sheet and the ultraremovable adhesive is directly on the cardstock sheet (*figure 2*).

8. Claims 140, 141, 142, 144, 148, 156, 157, 160, 164, 171, 182, 183, 184, 186, 190, 198, 199, 202, 205, 214, 222 and 223 are rejected under 35 U.S.C. 102(b) as being anticipated by Kennedy, Jr. (U.S. Patent No. 3,420,364).

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Kennedy discloses tags to be printed in a computer or other printing apparatus, in which the tags are non-tacky on both sides when removed (*col. 1, lines 25-27*).

Regarding Applicant's claims 140, 182 and 223, Kennedy discloses a sheet of printable tags (*title*).

The preamble "business cards" is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

The tag comprises a cardstock sheet construction (*tag, col. 1, lines 65*) which is deemed to have a front side and a back side, a solid continuous liner sheet (*backing, col. 1, line 63*) releasably secured with ultraremovable adhesive (*pressure sensitive adhesive, col. 1, lines 63-64*) to and covering the back side (*figures 4 and 5*). The pressure sensitive adhesive is deemed to be an ultraremovable adhesive since the adhesive is completely removable from the tags (*col. 1, lines 25-27 and col. 2, lines 51-54*) Portions of the back side of the cardstock sheet construction are deemed to form back side surfaces of the tag.

Continuous through-cut lines (*die cuts, col. 2, lines 37*) through the cardstock sheet construction to the back side but not through the liner sheet and define at least in part perimeter edges of the tags and a matrix waste portion (*figures 1 and 4*). Areas of the liner sheet covering back sides of all of the through-cut lines (*figure 4 and col. 1, lines 30-45*). The areas are adapted to hold the tags and the matrix waste portion together (*figure 4 and col. 1, lines 30-45*).

The limitation “when the sheet of printable business cards is sheet fed through a printer or copier for a printing operation of the printable business cards” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

The ultraremovable adhesive covers the entirety of the back side of the cardstock sheet construction (*figure 4*).

The liner sheet, the ultraremovable adhesive and the through-cut lines are adapted to allow the tags to be removed from the liner sheet and from the matrix waste portion into individual tags (*figure 5 and col. 1, lines 30-45*).

The limitation “after the printing operation” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

The liner sheet, the ultraremovable adhesive and the through-cut lines are adapted to allow the tags to be removed from the liner sheet and from the matrix waste portion into the individual tags with the ultraremovable adhesive remaining on the liner sheet and not on back side surfaces of the tags (*figure 5 and col. 1, lines 30-45*).

Furthermore, the back side surfaces of the tags are tack-free after removal from the liner sheet (*col. 1, lines 26-29*).



Regarding Applicant's claims 141 and 183, Kennedy discloses that the liner sheet covers all of the back sides of all of the facestock through-cut lines (*figure 1 and col. 1, lines 30-45*).

Regarding Applicant's claims 142 and 184, Kennedy discloses that the liner sheet extends the entire width of the cardstock sheet construction (*figure 1 and col. 1, lines 30-45*).

Regarding Applicant's claims 144 and 186, Kennedy discloses that the tags are arranged in a matrix on the cardstock sheet construction (*figure 1*).

Regarding Applicant's claims 148 and 190, Kennedy discloses that at least some of the through-cut lines define the matrix waste portion around the tags (*figure 1*).

Regarding Applicant's claims 156 and 198, Kennedy discloses that the liner sheet covers the entire back side of the cardstock sheet construction (*figure 1 and col. 1, lines 30-45*).

Regarding Applicant's claims 157 and 199, Kennedy discloses that at least some of the through-cut lines define all of the perimeter edges of the tags (*figure 1*).

Regarding Applicant's claims 160 and 202, Kennedy discloses that the tags comprise a matrix block of tags completely surround by the matrix waste portion (*figure 1*).

Regarding Applicant's claims 164 and 205, Kennedy discloses that the cardstock sheet construction and the liner sheet are both rectangular and have the same width and length (*figure 1*).

Regarding Applicant's claim 171, 214 and 222, the back side surfaces of the tags are deemed to be writable thereon by a user after removal from the liner sheet, since the reference discloses that there is no adhesive on the backside of the tags (*col. 1, lines 26-29*).

Regarding Applicant's claim 177 and 217, the cardstock sheet construction includes a cardstock sheet and the ultraremovable adhesive is directly on the cardstock sheet (*figure 4*).

***Claim Rejections - 35 USC § 103***

9. Claims 143, 146, 149-152, 158, 159, 178, 185, 188, 191-194, 200, 201 and 218 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy in view of Popat et al. (U.S. Patent No. 5,407,718).

Kennedy is relied upon as described above.

Kennedy fails to disclose tag arrangement as claimed in claims 143, 146, 149-152, 158, 159, 178, 185, 188, 191-194, 200, 201 and 218.

Popat discloses label sheets used for printing with personal computers (*col. 1, lines 12-19*). The label sheets comprise a label layer and backing layer secured with adhesive (*col. 3, lines 6-9*). The figures show that the label layer label layer has a front side and a back side and those portions of the back side of the label layer forming back side surfaces of the label.

Die cut lines extend through the label layer and through the adhesive layer, but do not pierce the backing layer. The backing layer remains intact as the labels are removed one by one, allowing the labels to be conveniently stored on the full sheet when only a few labels are left (*col. 3, lines 15-21*). Popat further discloses that die cuts form the numerous labels (*col. 2, lines 64-66*) and additional die cuts are provided to form flexible edges (*col. 3, lines 1-2*). Popat's die cut lines read on Applicant's claimed "continuous through-cut lines through the cardstock sheet construction to the back side but not through the liner sheet." As shown in figure 1 the die cut lines define at least in part perimeter edges of the printable label and a matrix waste portion.

Since the backing layer remains intact as the labels are removed one by one (*col. 3, lines 15-21*), the areas of the sheet covers the back sides of all the die cut lines and thereby constructed

and adapted to hold the label and the flexible edges, Applicant's "matrix waste portion," together if the label sheet is fed through a printer or copier for a printing operation on the labels.

Since additional die cuts are provided to form flexible edges (*col. 3, lines 1-2*), which separate the edge portions from the labels and the backing layer remains intact as the labels are removed one by one (*col. 3, lines 15-21*), the backing layer and the die cut lines are constructed and adapted to allow the labels to be removed from the backing layer and the flexible edges and separated after a printing operation into individual labels.

Regarding Applicant's claims 143 and 185, Popat shows in figure 1 that the labels directly abut one another and share common edges and are arranged in a matrix.

Regarding Applicant's claims 146 and 188, figure 1 in Popat shows that the label layer includes left and right side edges, the die cut lines include frame cut lined and grid cut line, the frame cut lines include first and second side cut lines spaced in from the left and right side edges respectively, and disposed parallel thereto, and first and second end cut lines spaced in from and parallel to the first and second edges, both of the end cut lines engaging both of the side cut lines, the frame cut lines defining a central area on the label layer, the grid cut lines defining a grid disposed in the central area, and the grid cut lines and the frame cut lines separating the central area into printable labels.

Regarding Applicant's claims 149-152 and 191-194, figure 1 in Popat shows that at least some of the die cut lines define a waste border portion of the label layer around the label, the die cut lines include vertical and horizontal cut lines. The top one of the horizontal cut lines extends a full width of the label layer and the ends of the rest of the horizontal cut lines are spaced inwardly from the left and right side edges of the label layer.

Regarding Applicant's claims 158, 159, 200 and 201, Popat shows in figure 1 that the die cut lines define all of the perimeter edges of all the labels and the labels are arranged in a two column matrix. Figure 1 further shows that the labels in each column of the two-column matrix abut adjacent labels in the same column separated only by respective ones of the die cut lines. The matrix block of labels is surrounded by a waste cardstock sheet perimeter.

Regarding Applicant's claims 178 and 218, Popat discloses that the label sheet may be a standard 8.5 x 11 inches sheet (*col. 5, line 5*).

Kennedy and Popat are analogous because they both discloses tags/labels for printing with personal computers.

It would have been obvious to one of ordinary skill in the art at the time of the invention to Popat's arrangement of labels and the tag arrangement of Kennedy in order to maximize the number of tags per sheet. One of ordinary skill in the art would have been motivated to use Popat's label arrangement because it helps prevent jamming in complex printer paths (*Popat col. 2, lines 5-6*).

10. Claims 145, 161, 180, 187, 203 and 220 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy in view of Carlson (U.S. Patent No. 5,842,722).

Kennedy is relied upon as described above.

Kennedy fails to disclose that the cardstock sheet is coated/glossy.

Carlson discloses a printable laminate useful in forming die-cut identification cards, labels, etc. (*col. 1, lines 16-18*). The printable laminate includes die cut cards, which are coated

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with an ink receptive coating (*col. 19, line 50 through col. 20, line 3*). The ink receptive coating provides good ink image retention and adhesive retention (*col. 20, lines 1-3*).

Kennedy and Carlson are analogous because they discuss printable tags/labels.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add Carlson's ink receptive coating to the tag of Kennedy in order to enhance the adhesion of the ink to the label. One of ordinary skill in the art would have been motivated to employ Carlson's ink receptive coating because of the improved image retention and adhesive retention of the ink (*col. 20, lines 1-3*). It is desirable to enhance the adhesion of the ink to the label so that the ink would not rub off after being applied to the label.

11. Claims 147, 153-155, 163, 179 and 181 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy in view of Cross (U.S. Patent No. 4,863,772).

Kennedy are relied upon as described above.

Kennedy fail to disclose that the liner sheet is a base paper sheet such as densified bleached kraft paper or the thickness of the liner sheet.

Cross discloses label stock comprising a facestock paper, a pressure-sensitive adhesive, a layer of low density polyethylene (film), and denisified bleached kraft paper release layer with a thickness of 3.1 mil (*figure 5 and col. 5, lines 1-38*).

Kennedy and Cross are analogous because they all discuss label/tag constructions..

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Cross' denisified bleached kraft paper as the liner sheet of Kennedy, since it would have been within the general skill of a worker in the art to select a known material

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on the basis of its suitability for the intended use, unless denisified bleached kraft paper gives unexpected results. *In re Leshin*, 125 USPQ 416.

The exact thickness of the backing layer is deemed to be a result effective variable with regard to size of paper acceptable for sending through a printer. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a result effective variable, such as combined thickness of layers through routine experimentation in the absence of a showing of criticality in the claimed thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to change the size of the layers in order to accommodate the machine in which the sheet was intended to be used in.

12. Claims 172-174 and 212-213 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy in view of Klein (U.S. Patent No. 5,198,275).

Kennedy are relied upon as described above.

Kennedy fails to disclose that the liner sheet includes a flexibility/cut line.

Klein discloses a card stock sheet for labels (*col. 3, line 13*) comprising a lift out panel with rectangular score cuts, an adhesive, and a backing sheet with perforations (*figure 6*). The backing sheet with perforations corresponds to Applicant's liner sheet with flexibility/cut lines. The perforations ensure a smooth peripheral edge of each panel and smoothness of the edge at the panel face is enhanced without any roughness or frying or torn paper (*col. 3, lines 62-66*).

Kennedy and Klein are analogous because they discuss label/tag constructions.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add Klein's perforations to the backing layer suggested by the combination of Popat and Marschke in order to facilitate easy removal of the web. One of ordinary skill in the art would have been motivated to use Klein's perforations as taught in col. 3, lines 62-66, where Klein teaches that the perforations ensure a smooth peripheral edge without any roughness of frying or torn paper.

The exact distance of the liner sheet cut lines to the end of the sheet is deemed to be a result effective variable. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a result effective variable, such as distance of liner sheet cut line to the end of the sheet through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

13. Claims 175, 176, 215 and 216 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy in view of Hickenbotham et al. (U.S. Patent No. 4,704,317).

Kennedy is relied upon as described above.

Kennedy fails to disclose that the an edge of the sheet is thinner than a body of the sheet or that the sheet is calendered.

Examiner's comment: The limitation "the lead-in edge of the printable business card sheet is calendered" is a process limitation. However, this process limitation does add structure to the end product by crushing, compressing, making the calendered end thinner. So, for purposes of examination, any process that results in a crushed, compressed or thinner end is

taken to anticipate the limitation “the lead-in edge of the printable business card sheet is calendared,” since the method of forming the product is not germane to the issue of patentability of the product itself.

Hickenbotham discloses crushing the corner of lablestock for use in printers or copier to provide a diagonal path of relatively low stiffness (*col. 6, lines 9-16*). The low stiffness in the front edge of the sheet allows the sheet to be dispensed through the printer or copier with greater easier (*col. 1, lines 38-51*).

Kennedy and Hickenbotham are analogous because they all discuss label/tag constructions.

It would have been obvious to one of ordinary skill in the art at the time of the invention to crush the edge of the sheet of Kennedy as taught by Hickenbotham, in order to make the edge thinner than the rest of the sheet and to facilitate dispensing.

One of ordinary skill in the art would have been motivated to crush the edge of the sheet because crushing the edge would provide a path of relatively low stiffness and would make the sheet easier to be dispensed through a printer as taught by Hickenbotham at *col. 1, lines 38-51*.

It is desirable to have the sheet be easily dispensed through a printer so that the sheet does not get jammed in the printer.

14. Claims 140, 165, 182 and 206 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casagrande (5,782,497) in view of Marschke (U.S. Patent No. 5,209,810).

Regarding Applicant's claims 139 and 165, Casagrande discloses removable cards used for business cards (*col. 1, lines 16-24*). The cards comprise a form layer, Applicant's “cardstock



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sheet construction,” and base paper layer secured with adhesive, Applicant’s “liner sheet” (*col. 2, lines 26-42*). The figure shows that the form layer has a front side and a back side and those portions of the back side of the form layer forming back side surfaces of the cards.

Die cut lines extend through the form layer and through the adhesive layer, but not pierce the base paper layer (*col. 2, lines 38-42 and the figure*). Casagrande’s die cut lines read on Applicant’s claimed “continuous through-cut lines through the cardstock sheet construction to the back side but not through the liner sheet.” As shown in the figure the die cut lines define at least in part perimeter edges of the printable label and a matrix waste portion. Since Casagrande’s base paper layer is not die cut and is left as a full sheet it reads on Applicant’s “a solid continuous liner sheet releasably secured to and covering the back side.”

Since the base paper layer is not die cut (*the figure*), the areas of the sheet covers the back sides of all the die cut lines and thereby constructed and adapted to hold the cards and matrix waste portion (*the figure*) together if the label sheet is fed through a printer or copier for a printing operation on the labels. Also, the phrase “adapted to hold the printable business cards and matrix waste portion together when the sheet of printable business card is sheet fed through a printer or copier for a printing operation on the printable business cards” is functional limitation. In the absence of convincing objective evidence the adaptation is deemed a latent property. MPEP 2145 (II).

As seen in the figure the base paper layer covers the entire backside of the form layer except for a narrow strip along a leading edge of the form sheet.

Casagrande fails to disclose that the adhesive is an “ultraremovable adhesive.”

Marschke discloses adhesive backed sheets, where the adhesive is a low tack ultra-removable adhesive so that the sheet is easily removable and reattachable (*col. 1, lines 44-46*).

Casagrande and Marschke are analogous because they are both discuss adhesively backed sheets.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Marschke's ultra-removable adhesive as the adhesive in Casagrande in order to utilize a low tack adhesive. One of ordinary skill in the art would have been motivated to use a low tack adhesive because it would allow the label to be easily removed and reattached. It is desirable to have a removable and reattachable label so that the user can reuse the label.

15. Claims 169, 170, 210 and 211 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casagrande (5,782,497) in view of Marschke (U.S. Patent No. 5,209,810) as applied to claims 139 and 165 above, and further in view of Hickenbotham et al. (U.S. Patent No. 4,704,317).

Casagrande and Marschke are relied upon as described above.

Casagrande and Marschke fail to disclose that the an edge of the sheet is thinner than a body of the sheet or that the sheet is calendered.

Examiner's comment: The limitation "the lead-in edge of the printable business card sheet is calendered" is a process limitation. However, this process limitation does add structure to the end product by crushing, compressing, making the calendered end thinner. So, for purposes of examination, any process that results in a crushed, compressed or thinner end is taken to anticipate the limitation "the lead-in edge of the printable business card sheet is

calendared,” since the method of forming the product is not germane to the issue of patentability of the product itself.

Hickenbotham discloses crushing the corner of lablestock for use in printers or copier to provide a diagonal path of relatively low stiffness (*col. 6, lines 9-16*). The low stiffness in the front edge of the sheet allows the sheet to be dispensed through the printer or copier with greater easier (*col. 1, lines 38-51*).

Popat, Marschke and Hickenbotham are analogous because they all discuss label constructions/adhesively backed sheets.

It would have been obvious to one of ordinary skill in the art at the time of the invention to crush the edge of the sheet suggested by the combination of Casagrande and Marschke above, as taught by Hickenbotham, in order to make the edge thinner than the rest of the sheet and to facilitate dispensing.

One of ordinary skill in the art would have been motivated to crush the edge of the sheet because crushing the edge would provide a path of relatively low stiffness and would make the sheet easier to be dispensed through a printer as taught by Hickenbotham at *col. 1, lines 38-51*. It is desirable to have the sheet be easily dispensed through a printer so that the sheet does not get jammed in the printer.

#### ***Potential Allowable Subject Matter***

16. Claims 166-168 and 207-209 are objected to as being dependent upon a rejected base claim, but might be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. Claims 224-226 are allowed.

***ANSWERS TO APPLICANT'S ARGUMENTS***

18. Applicant's arguments in the response filed April 19, 2004 regarding the previous rejections of record have been considered but are moot due to the new grounds of rejection.

***Conclusion***

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac



9/20/04